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DAVID A. BURGE CO, L.P.A. 2901 SOUTH PARK BOULEVARD CLEVELAND, OH 44120-1842			EDWARDS, LAURA ESTELLE	
		ART UNIT	PAPER NUMBER	
		1734		

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/807,953	BECHTOLD, JOSEPH A.
Examiner	Art Unit	
Laura Edwards	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 April 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-48 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 18-23,30,31,34-39 and 48 is/are allowed.
 6) Claim(s) 1-17,24-29,32,33 and 40-47 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 12, 13, 17, 24-29, and 40-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to teach or suggest the paint shield elements being made of a stiff material that “will not curl or roll up” or that the paint shield is held “in place without a need for additional fastening” as recited in independent claims 1, 17, 24, and claim 40. The newly claimed negative limitations are not explicitly or implicitly taught or suggested in the original specification such that such negative limitations constitute new matter.

Claims 10, 11, 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, line 5, “the front face” lacks antecedent basis.

In claim 14, line 5, “the front face” lacks antecedent basis.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-9, 17, 24-29, 40-42, 44, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panitzsch (US 1,817,928).

Panitzsch teaches a plural element paint shield device for temporarily covering an article being painted comprising plural paint shield elements (16, 17) configured to protectively cover a portion of a front face of an article (see pg. 1, lines 1-7 and lines 70-77) when in an installed position wherein the paint shield elements slidably extend in an adjacent side by side relationship to cover the front face of the article with adjacent ones of the paint shield elements having portions to extend between the frame of the article and perimeter portions of the article with each paint shield element being formed of a thin flat flexible material to permit the device to be bent (see pg. 1, lines 98+ to pg. 2, lines 1-4) as well as permit the paint shield elements to be inserted in between the frame of the article and a front face of the article. Panitzsch is silent concerning 1) the material used to make the shield elements, the material being stiff pliable material that does not curl or roll up, and 2) the device being capable of protecting an article from paint without the need of fastening means to hold it in place. Even though Panitzsch is silent concerning the specific type of material (i.e., plastic, cardboard, fiberboard, or chipboard), used to make the paint shield elements, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the paint shield elements from plastic, cardboard, fiberboard, or chipboard, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of

obvious design choice. *In re Leshin*, 125 USPQ 416. The making of the Panitzsch device from any known flexible material so as to enable coverage of the article being painted, whether said material does not curl or roll up, is within the purview of one skilled in the art. While the Panitzsch device appears to slidably attach a pin strip fastening means to the flexible shield elements to support the shield elements against a window frame or other article of which there is no support for the shield elements (see page 1, lines 68-100 and page 2, lines 4-17), one of ordinary skill in the art would expect the removal of the pin strip fastening means from the flexible shield elements when support on or about an article is provided and when the presence of the strip would damage the article or the surrounding area intended to be protected.

With respect to claims 5 and 6, even though Panitzsch are silent concerning each of the paint shields being equal in size, it is within the purview of one skilled in the art to provide adjacent or overlapping paint shield elements of an appropriate size and/or dimension in accordance with the size and/or dimension of the area of the article intended to be masked.

With respect to claims 7-9, as mentioned above, the selection of a known material (i.e., plastic, cardboard, fiberboard, or chipboard) is obvious and within the level of ordinary skill in the art for reasons mentioned above such that patentability does not result.

With respect to claim 24, each of the paint shield elements are rectangular in form, flat, and flexible such that the Panitzsch device is capable of being used for masking a rectangular lens of a ceiling mounted light fixture.

With respect to claim 40, even though Panitzsch is silent concerning the device having exact dimensions to match the article being protected, one of ordinary skill in the art would

expect the masking device to have dimensions in accordance with the article being masked to provide complete coverage of all exposed surface areas of the article.

Allowable Subject Matter

Claims 18-23, 30, 31, 34-39, and 48 would be allowable.

Claims 4, 10-16, 32, 33, 43, 45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 4 would be allowable because there is no teaching or suggestion in the prior art of a plural element paint shield for temporarily protectively covering a front face of a lens of a light fixture comprising a plurality of paint shield elements each of which is configured to protectively cover a separate portion of the front face of the lens when in an installed position wherein the paint shield elements extend in adjacent side by side relationship to contiguously cover the front face of the lens, with adjacent ones of the paint shield elements having portions configured to overlap when the paint shield elements are in the installed position, with each of the paint shield elements having edge portions configured to extend between a frame of the light fixture and perimeter portions of the front face of the lens when in the installed position, and with each of the paint shield elements being formed from relatively thin, stiff material which is pliable enough to permit central portions thereof to flex away from the front face of the lens as may be needed to permit the edge portions to be inserted between the frame and the perimeter

portions of the front face of the lens to hold the paint shield in place wherein a foldable portion of at least a selected one of the paint shield elements is connected to other portions thereof by a fold line that permits the foldable portion to be deflected out of a plane occupied by said other portions thereof so as to strengthen the paint shield against deflection under the influence of the force of gravity.

Claims 10 and 11 would be allowable because there is no teaching or suggestion in the prior art of a plural element paint shield for temporarily protectively covering a lens of a light fixture comprising the combination of paint shield elements each configured to cover and protect a separate portion of a front face of the lens when in an installed position wherein the paint shield elements extend in adjacent side by side relationship to contiguously cover the front face of the lens, with adjacent ones of the paint shield elements having portions configured to overlap when the paint shield elements are in the installed position, with each of the paint shield elements having edge portions configured to extend between a frame of the light fixture and perimeter portions of the front face of the lens when in the installed position, and with each of the paint shield elements being formed from relatively thin, relatively stiff material that is pliable enough to permit central portions thereof to flex away from the front face of the lens as may be needed to permit the edge portions to be inserted between the frame and the perimeter portions of the front face of the lens, wherein at least one of the paint shield elements has a central region formed from material that permits light from a light fixture on which the paint shield is installed to pass therethrough, and a perimeter region that surrounds the central region formed from thin, relatively stiff stock selected from a group of materials that includes cardboard, fiberboard,

chipboard, substantially transparent plastic, substantially translucent plastic and substantially opaque plastic.

Claim 12 would be allowable because there is no teaching or suggestion in the prior art of a plural element paint shield for temporarily protectively covering a front face of a lens of a light fixture comprising a plurality of paint shield elements each of which is configured to protectively cover a separate portion of the front face of the lens when in an installed position wherein the paint shield elements extend in adjacent side by side relationship to contiguously cover the front face of the lens, with adjacent ones of the paint shield elements having portions configured to overlap when the paint shield elements are in the installed position, with each of the paint shield elements having edge portions configured to extend between a frame of the light fixture and perimeter portions of the front face of the lens when in the installed position, and with each of the paint shield elements being formed from relatively thin, stiff material which is pliable enough to permit central portions thereof to flex away from the front face of the lens as may be needed to permit the edge portions to be inserted between the frame and the perimeter portions of the front face of the lens to hold the paint shield in place wherein all of the paint shield elements are comprised of thin material that, when in the installed position, closely overlies so as to extend substantially flatly alongside the front face of the lens of the light fixture, except that at least one of the paint shield elements has at least one portion that can be oriented to extend away from the front face of the lens so as to strengthen the paint shield to inhibit deflection of central portions of the paint shield under the influence of the force of gravity.

Claim 13 would be allowable because there is no teaching or suggestion in the prior art of a plural element paint shield for temporarily protectively covering a front face of a lens of a light

fixture comprising a plurality of paint shield elements each of which is configured to protectively cover a separate portion of the front face of the lens when in an installed position wherein the paint shield elements extend in adjacent side by side relationship to contiguously cover the front face of the lens, with adjacent ones of the paint shield elements having portions configured to overlap when the paint shield elements are in the installed position, with each of the paint shield elements having edge portions configured to extend between a frame of the light fixture and perimeter portions of the front face of the lens when in the installed position, and with each of the paint shield elements being formed from relatively thin, stiff material which is pliable enough to permit central portions thereof to flex away from the front face of the lens as may be needed to permit the edge portions to be inserted between the frame and the perimeter portions of the front face of the lens to hold the paint shield in place wherein at least one of the paint shield elements carries a visual indicator guide trimming edge portions thereof when there is a need cut away said edge portions to permit the paint shield to be used with light fixture lenses that have at least one dimension that differs from at least one dimension of the at least one of the paint shield elements.

Claims 14-16 would be allowable because there is no teaching or suggestion in the prior art of a plural element paint shield for temporarily protectively covering a front face of a lens of a light fixture comprising a plurality of paint shield elements each of which is configured to protectively cover a separate portion of the front face of the lens when in an installed position wherein the paint shield elements extend in adjacent side by side relationship to contiguously cover the front face of the lens, with adjacent ones of the paint shield elements having portions configured to overlap when the paint shield elements are in the installed position, with each of

the paint shield elements having edge portions configured to extend between a frame of the light fixture and perimeter portions of the front face of the lens when in the installed position, and with each of the paint shield elements being formed from relatively thin, stiff material which is pliable enough to permit central portions thereof to flex away from the front face of the lens as may be needed to permit the edge portions to be inserted between the frame and the perimeter portions of the front face of the lens to hold the paint shield in place wherein the front face of the lens, wherein at least a selected portion of the perimeter of at least one of the paint shield elements is provided with a plurality of visible guide formations extending therealong to guide cutting of said one of the paint shield elements to a size that will permit at least one of the paint shield elements to properly cover front face portions of lenses of light fixtures of a variety of sizes.

Claims 18-20 would be allowable because there is no teaching or suggestion in the prior art of a paint shield for protectively covering a lens of a light fixture having a frame that extends perimetrically about and overlies perimeter portions of a front face of the lens, comprising a first paint shield element configured to cover one end region but not an opposite end region of the front face of the lens of the light fixture, a second paint shield element configured to cover the opposite end region but not the one end region of the front face of the lens of the light fixture, with the first and second paint shield elements being formed from relatively thin, relatively stiff material that is pliable enough to permit the first and second paint shield elements to have central portions thereof deflected away from the front face of the lens so that opposite side portions thereof can be inserted between opposite sides of the front face of the lens and opposite sides of the frame to bring the first and second elements into an initial overlapped relationship wherein

the elements cover neither of the one and opposite end regions of the lens, thereafter the first paint shield element may be slid toward the one end region, and the second paint shield element may be slid in an opposite direction toward the opposite end region to installed positions of the first and second paint shield elements wherein the first paint shield element covers the one end region of the front face of the lens, wherein the second paint shield element covers the opposite end region of the front face of the lens, and wherein overlapping portions of the first and second paint shield elements cover a central region of the front face of the lens to prevent paint from being applied to the lens during painting of a front face of the frame, wherein the relatively thin, relatively stiff material that forms at least one of the first and second paint shield elements is connected by a line of weakness of the material to a portion of the material that can be folded down to project away from the front face of the lens of the light fixture so as to stiffen said at least one of the first and second paint shield elements.

Claims 21-23 would be allowable because there is no teaching or suggestion in the prior art of a paint shield for protectively covering a lens of a light fixture having a frame that extends perimetrically about and overlies perimeter portions of a front face of the lens, comprising a first paint shield element configured to cover one end region but not an opposite end region of the front face of the lens of the light fixture, a second paint shield element configured to cover the opposite end region but not the one end region of the front face of the lens of the light fixture, with the first and second paint shield elements being formed from relatively thin, relatively stiff material that is pliable enough to permit the first and second paint shield elements to have central portions thereof deflected away from the front face of the lens so that opposite side portions thereof can be inserted between opposite sides of the front face of the lens and opposite sides of

the frame to bring the first and second elements into an initial overlapped relationship wherein the elements cover neither of the one and opposite end regions of the lens, thereafter the first paint shield element may be slid toward the one end region, and the second paint shield element may be slid in an opposite direction toward the opposite end region to installed positions of the first and second paint shield elements wherein the first paint shield element covers the one end region of the front face of the lens, wherein the second paint shield element covers the opposite end region of the front face of the lens, and wherein overlapping portions of the first and second paint shield elements cover a central region of the front face of the lens to prevent paint from being applied to the lens during painting of a front face of the frame, wherein selected portions of the perimeters of the first and second paint shield elements are provided with visible guide formations that extend therealong to guide one in cutting the first and second paint shield elements down to sizes that will permit the first and second paint shield elements to cover the front faces of the lenses of light fixtures of a variety of sizes.

Claims 30 and 31 are allowable because there is no teaching or suggestion in the prior art of a self-supporting easy-to-install and easy-to-remove paint shield for covering a generally rectangular lens of a ceiling mounted light fixture of the type having a frame lip that underlies perimetricaly extending edge portions of the generally rectangular lens, wherein the generally rectangular lens has a first pair of substantially parallel extending opposed edges separated by a first dimension that defines a length of the generally rectangular lens, and has a second pair of substantially parallel extending opposed edges separated by a second dimension that defines a width of the generally rectangular lens, wherein the paint shield is comprised of a plurality of relatively thin, relatively stiff paint shield elements that are configured so that adjacent ones of

the paint shield elements have portions that overlap slightly when the paint shield elements are installed to closely underlie and to substantially fully cover a front face of the generally rectangular lens, with the installed paint shield elements having edge portions that extend between the frame lip and the perimetricaly extending edge portions of the lens so as to overlie the frame lip and to underlie the perimetricaly extending edge portions of the lens, with each of the paint shield elements being of a size that is less than the size of the front face of the generally rectangular lens, and with each of the paint shield elements having a pair of substantially parallel extending opposed edge surfaces that are spaced apart by a distance that substantially equals a selected one of said first and second dimensions, wherein at least one of the paint shield elements has a central region formed from material that permits light from a light fixture on which the paint shield is installed to pass therethrough, and a perimeter region that surrounds the central region formed from thin, relatively stiff stock selected from a group of materials that includes cardboard, fiberboard, chipboard, substantially transparent plastic, substantially translucent plastic and substantially opaque plastic.

Claim 32 would allowable because there is no teaching or suggestion in the prior art of a self-supporting easy-to-install and easy-to-remove paint shield for covering a generally rectangular lens of a ceiling-mounted light fixture having a frame lip that underlies perimetricaly extending edge portions of the generally rectangular lens, wherein the generally rectangular lens has a first pair of substantially parallel extending opposed edges separated by a first dimension that defines a length of the generally rectangular lens, and has a second pair of substantially parallel extending opposed edges separated by a second dimension that defines a width of the generally rectangular lens, wherein the paint shield is comprised of a plurality of

relatively thin, relatively stiff paint shield elements configured so that adjacent ones of the paint shield elements have portions that overlap slightly when the paint shield elements are installed to closely underlie and to substantially fully cover a front face of the generally rectangular lens, with the installed paint shield elements having edge portions that extend between the frame lip and the perimetrically extending edge portions of the lens so as to overlie the frame lip and to underlie the perimetrically extending edge portions of the lens to hold the paint shield so the front face of the lens is protected from being coated with paint during painting of adjacent front face portions of the frame, with each of the paint shield elements being of a size that is less than the size of the front face of the generally rectangular lens, and with each of the paint shield elements having a pair of substantially parallel extending opposed edge surfaces that are spaced apart by a distance that substantially equals a selected one of said first and second dimensions wherein the plurality of paint shield elements, when installed to protectively cover the front face of a light fixture lens, are comprised of thin material that closely overlies so as to extend substantially flatly alongside the front face of the lens of the light fixture, except that at least one of the paint shield elements has at least one portion that can be oriented to extend away from the front face of the lens so as to strengthen the paint shield to inhibit deflection of central portions of the paint shield under the influence of the force of gravity.

Claim 33 would allowable because there is no teaching or suggestion in the prior art of a self-supporting easy-to-install and easy-to-remove paint shield for covering a generally rectangular lens of a ceiling-mounted light fixture having a frame lip that underlies perimetrically extending edge portions of the generally rectangular lens, wherein the generally rectangular lens has a first pair of substantially parallel extending opposed edges separated by a

first dimension that defines a length of the generally rectangular lens, and has a second pair of substantially parallel extending opposed edges separated by a second dimension that defines a width of the generally rectangular lens, wherein the paint shield is comprised of a plurality of relatively thin, relatively stiff paint shield elements configured so that adjacent ones of the paint shield elements have portions that overlap slightly when the paint shield elements are installed to closely underlie and to substantially fully cover a front face of the generally rectangular lens, with the installed paint shield elements having edge portions that extend between the frame lip and the perimetrically extending edge portions of the lens so as to overlie the frame lip and to underlie the perimetrically extending edge portions of the lens to hold the paint shield so the front face of the lens is protected from being coated with paint during painting of adjacent front face portions of the frame, with each of the paint shield elements being of a size that is less than the size of the front face of the generally rectangular lens, and with each of the paint shield elements having a pair of substantially parallel extending opposed edge surfaces that are spaced apart by a distance that substantially equals a selected one of said first and second dimensions wherein at least one of the paint shield elements carries a visual indicator to guide trimming of edge portions of the paint shield when there is a need to cut away the edge portions so to permit the paint shield to be used with light fixtures that have at least one dimension that differs from the first and second dimensions.

Claims 34-36 would be allowable because there is no teaching or suggestion in the prior art of a self-supporting, easy to install and easy to remove paint shield for covering a generally rectangular lens of a ceiling mounted light fixture having a frame lip that underlies perimetrically extending edge portions of the rectangular lens, the lens having a first pair of parallel extending

opposed edges separated by a first dimension that defines a length of the rectangular lens, and a second pair of parallel extending opposed edges separated by a second dimension that defines a width of the rectangular lens, the shield comprised of a plurality of thin, stiff paint shield elements that are configured so that adjacent ones of the paint shield elements have portions that overlap slightly when the paint shield elements are installed to closely underlie and to fully cover a front face of the lens, with installed paint shield elements having edge portions that extend between the frame lip and the perimetrically extending edge portions of the lens to as to overlie the frame lip and to underlie the perimetrically extending edge portions of the lens, with each of the paint shield elements being of a size that is less than the size of the front face of the rectangular lens, and with each of the paint shield elements having a pair of parallel extending opposed edge surfaces that are spaced apart by a distance that equals a selected one of the first and second dimensions wherein selected portions of the perimeter of at least one of the paint shield elements are provided with visible guide formations that extend therealong to guide one in cutting said one of the paint shield elements to a size that will permit the at least one of the paint shield elements to properly cover front face portions of the lenses of light fixtures of a variety of sizes.

Claims 37-39 would be allowable because there is no teaching or suggestion in the prior art of a self-supporting, easy to install and easy to remove paint shield for covering a generally rectangular lens of a ceiling mounted light fixture having a frame lip that underlies perimetrically extending edge portions of the rectangular lens, the lens having a first pair of parallel extending opposed edges separated by a first dimension that defines a length of the rectangular lens, and a second pair of parallel extending opposed edges separated by a second dimension that defines a

width of the rectangular lens, the shield comprised of a plurality of thin, stiff paint shield elements that are configured so that adjacent ones of the paint shield elements have portions that overlap slightly when the paint shield elements are installed to closely underlie and to fully cover a front face of the lens, with installed paint shield elements having edge portions that extend between the frame lip and the perimetricaly extending edge portions of the lens to as to overlie the frame lip and to underlie the perimetricaly extending edge portions of the lens, with each of the paint shield elements being of a size that is less than the size of the front face of the rectangular lens, and with each of the paint shield elements having a pair of parallel extending opposed edge surfaces that are space apart by a distance that equals a selected one of the first and second dimensions wherein at least one of the paint shield elements has a fold-down portion that can be oriented to extend away from the lens of a light fixture to strengthen the paint shield when installed on said light fixture against deflection under the influence of the force of gravity.

Claim 43 would be allowable because there is no teaching or suggestion in the prior art of a paint shield for temporarily protectively covering a rectangular lens of a ceiling mounted light fixture to shield the lens from having paint applied thereto when paint is being applied within the vicinity of the light fixture, wherein the generally rectangular lens has a width dimension and a length dimension, and wherein the fixture has a frame lip that extends about and underlies peripheral edge portions of the lens, comprising a plurality of paint shield elements being formed from relatively thin, relatively stiff material wherein the paint shield elements are configured to be positioned side by side in an array that forms a rectangular cover having length and width dimensions that substantially equal the length and width dimensions of the lens, and wherein the array of paint shield elements has peripheral edge portions configured to be inserted between the

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frame lip and the peripheral edge portions of the lens to hold the paint shield in place, with the elements supported in positions that closely underlie the lens when the array of paint shield elements is installed to protectively cover the lens wherein one of the paint shield elements is provided with a stiffening formation that extends transversely across at least a selected portion of the one of the paint shield elements..

Claim 45 would be allowable because there is no teaching or suggestion in the prior art of a paint shield for temporarily protectively covering a rectangular lens of a ceiling mounted light fixture to shield the lens from having paint applied thereto when paint is being applied within the vicinity of the light fixture, wherein the generally rectangular lens has a width dimension and a length dimension, and wherein the fixture has a frame lip that extends about and underlies peripheral edge portions of the lens, comprising a plurality of paint shield elements being formed from relatively thin, relatively stiff material wherein the paint shield elements are configured to be positioned side by side in an array that forms a rectangular cover having length and width dimensions that substantially equal the length and width dimensions of the lens, and wherein the array of paint shield elements has peripheral edge portions configured to be inserted between the frame lip and the peripheral edge portions of the lens to hold the paint shield in place, with the elements supported in positions that closely underlie the lens when the array of paint shield elements is installed to protectively cover the lens wherein the first and second paint shield elements are substantially identical, with each being formed from relatively thin, relatively stiff material, and each has a stiffening formation that extends transversely across at least selected portions thereof.

Claim 48 would be allowable because there is no teaching or suggestion in the prior art of a paint shield for temporarily protectively covering a rectangular lens of a ceiling mounted light fixture to shield the lens from having paint applied thereto when paint is being applied within the vicinity of the light fixture, wherein the rectangular lens has a width dimension and a length dimension, and wherein the fixture has a frame lip that extends about and underlies peripheral edge portions of the lens, comprising a plurality of paint shield elements configured to be positioned side by side in an array that forms a rectangular cover having length and width dimensions that substantially equal the length and width dimensions of the lens, and wherein the array of paint shield elements has peripheral edge portions configured to be inserted between the frame lip and the peripheral edge portions of the lens to support the elements in positions that closely underlie the lens when the array of paint shield elements is installed to protectively cover the lens, wherein at least one of the paint shield elements has a central region formed from material that permits light from the fixture to pass through the installed array of paint shield elements, and a perimeter region that surrounds the central region formed from thin, relatively stiff stock selected from a group of materials that includes cardboard, fiberboard, chipboard and plastic.

Response to Arguments

Applicant's arguments filed 4/8/05 have been fully considered but they are not persuasive.

Applicant contends that the presently claimed invention is patentable over the Panitzsch paint shield because Panitzsch does not use the paint shield to protect a lens of a light fixture and

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the Panitzsch paint shield could not be used to protect a lens of a light fixture because of the pins used which would damage the area intended to be protected. This argument is not deemed persuasive because even though Panitzsch is silent concerning the paint shield being used with a light fixture, the Panitzsch paint shield is capable of use with a light fixture via detachment of the pin strip from the flexible paint shield elements. It is the Examiner's position that even if the pin strip remained on a given flexible paint shield element, one of ordinary skill in the art would know that the flexible paint shield elements could be tucked into the framework about the lens or even draped over the framework. The Panitzsch paint shield is not limited to woodwork or windows or doors because Panitzsch recognizes the paint shield being used with an article in general in paragraph 1, lines 1-7. The pins of the Panitzsch paint shield would only need to be utilized when a given paint shield element needed support because no support was provided on or about the work being protected.

Applicant contends that the presently claimed invention defines over Panitzsch because the Panitzsch paint shield curls or rolls up while the presently claimed invention is formed so as to not curl or roll up. This argument is deemed moot because the no curl, no roll up language is construed as new matter. However, even if such language was not deemed new matter, Applicant recognizes that the paint shield element can be made out of cardboard. Cardboard can be made to curl or roll up as desired such that such language would conflict with materials from which the instantly claimed invention could be made. Furthermore, Applicant's no curl, no roll language would still not clearly define the claimed invention over the prior art to Panitzsch because the determination of a suitable material from which to make the flexible paint shield elements is within the purview of one skilled in the art such that patentability would not result.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Laura Edwards
Primary Examiner
Art Unit 1734

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May 25, 2005